

REMARKS

Upon entry of the present amendment, claims 9, 17-20, and 23-32 are pending. Support for the amendments to claim 17 can be found in the specification at page 22, first paragraph. No new matter is added by this amendment.

The Examiner rejected claims 1-22 under 35 USC 112, first paragraph as lacking enablement for the entire scope of compounds embraced by formula (A). The Examiner alleges that "the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. While neither agreeing nor disagreeing with the Examiner, and merely to advance the prosecution of the present application, Applicants have cancelled claim 1 and limited the scope of the active compound used in the composition to the species recited in claim 9. Claim 10 has been replaced with claim 25 and new claims 26-29 are provided to claim a preferred embodiment.

Applicants respectfully submit that the present specification is enabling for the species set forth in claim 9. A general process for preparing the generic compounds formerly claimed in claim 1, which includes the structurally-related species claimed in claim 9, is known from the prior art and described in EP-A-580553. The Examiner has not provided specific reasons why the teachings in the EP reference do not enable one of ordinary skill in the art to make the claimed compounds, especially now that the claimed compounds are so structurally similar and do not include varying structural substituents. Accordingly, Applicants respectfully request withdrawal of the 112, paragraph 1, rejection.

The Examiner rejected claims 1-10, 17 and 19 under 35 USC 103(a) as being unpatentable in light of Morie et al (JP 07224062) and Baranowski. According to the Examiner, Morie teaches an insecticidal composition comprising compounds of formula (A) and a method of controlling insects with the compositions. According to the Examiner, Morie does not teach the composition or method comprising abamectin. For this element, the Examiner relies on Baranowski, which he characterizes as teaching an insecticidal composition of abamectin and a method of controlling insects therewith. According to the Examiner, "it would have been obvious to one having ordinary skill in the art to modify the invention taught by Morie to include the abamectin taught by Baranowski. One would have been motivated to do this since each reference have (*sic*) the same utility, i.e., each

reference discloses insecticidal inventions." Applicants respectfully traverse this rejection for the reasons already of record.

As previously noted, the Morie reference is directed to the preparation of nitroimidotetrahydrooxadiazines as insecticides, and embraces compounds falling within the scope of the present claims. The Morie reference specifically discloses the use of the active compounds for control of *Myzus persicae*. The Baranowski reference is directed to avermectins as active ingredients for pesticidal plant protection. Specifically, the Baranowski reference teaches that avermectins possess a "unique mode of action. It is chemical unrelated to other miticide or insecticide." Further, Baranowski teaches that abamectin is "not considered disruptive to natural predators or beneficial insects." Thus, the teaching of Baranowski is that abamectin is a selective insecticide; it does not teach the "same utility" as the Morie reference, as alleged by the Examiner. The Examiner maintains the rejection of record and rejects Applicants' arguments based on an assertion that "the resulting combination would have been expected to at least yield an additive effective and/or broaden the effectiveness of the composition when actives are used together as opposed to alone." The Examiner fails to provide any support for this statement other than the simple assertion that "they are both generally classified as insecticides." Applicants note that such assertion is incorrect. The Baranowski reference does not provide a general assertion of insecticidal activity; rather it describes *selective* insecticidal activity. As the Morie reference fails to include a disclosure of the same type of selectivity and specifically excludes the selectivity described in Baranowski, Applicants respectfully submit that the references are not properly combined and the motivation provided by the Examiner does not exist.

The Examiner rejected claims 1-10, 17 and 19 under 35 USC 103(a) as being unpatentable over Matsuo (JP 08291171) and Baranowski for the reasons of record. The Examiner alleges that Matsuo teaches an insecticidal composition comprising a compound of formula (A) and a method of controlling insects with the compound. According to the Examiner, Matsuo does not teach the composition or method comprising abamectin. For this, the Examiner relies on Baranowski, which he says teaches a method for controlling insects with abamectin. According to the Examiner, it would have been obvious to one of ordinary skill in the art to modify the invention taught by Matsuo to include the abamectin

taught by Baranowski since the references have the same utility. Applicants respectfully traverse for the reasons already of record.


Specifically, the Matsuo reference is directed to the preparation of nitroiminotetrahydrooxadiazines as insecticides, and embraces compounds falling within the scope of the present claims. The Matsuo reference specifically discloses the use of the active compounds for control of *Laodelphas striatellus* and *Nephotettix cincticeps* on rice seedlings and adult *Spodoptera litura* on sweet potato leaves. The Baranowski reference is directed to avermectins as active ingredients for pesticidal plant protection. Specifically, the Baranowski reference teaches that avermectins possess a "unique mode of action. It is chemical unrelated to other miticide or insecticide." Further, Baranowski teaches that abamectin is "not considered disruptive to natural predators or beneficial insects." Thus, the teaching of Baranowski is that abamectin is a selective insecticide; it does not teach the "same utility" as the Matsuo reference, as alleged by the Examiner. Accordingly, there is no motivation to combine the two references. Applicants respectfully request withdrawal of the rejections under 35 USC § 103(a).

The Examiner objected to claims 20 and 24 as being of improper dependent form for failing to limit the subject matter of a previous claim. The Examiner asserts that a claim to a material should not depend from a claim to a method. Although disagreeing with the Examiner, Applicants have now amended the product claims to reflect that the plant propagation material is treated with the compositions previously claimed.

In light of the amendments and remarks set forth herein, Applicants respectfully request withdrawal of all rejections and solicit early allowance of all of the claims.

Respectfully submitted,

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